



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,886	09/15/2003	Chris Quinlan	PNM01 010 CONT	8510
39290	7590	06/01/2007		
DUANE MORRIS LLP 1667 K. STREET, N.W. SUITE 700 WASHINGTON, DC 20006-1608			EXAMINER LASTRA, DANIEL	
			ART UNIT 3622	PAPER NUMBER
			MAIL DATE 06/01/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/661,886

Applicant(s)

QUINLAN ET AL.

Examiner

DANIEL LASTRA

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 84-101 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 84-101 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 02/20/2007.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 84-101 have been examined. Application 10/661,886 (METHOD AND SYSTEM FOR REDEEMING PRODUCT MARKETING REBATES) has a filing date 09/15/2003 is a continuation of 09495819 (02/02/2000; Pat: 6748365), Which Claims Priority from Provisional Application 60154087 (09/15/1999).

Response to Amendment

2. In response to Non Final Rejection filed 06/29/2006, the Applicant filed an Amendment on 02/20/2007, which amended claims 84, 86-88 and 90-94.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 84-101 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,748,365. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are obvious variations of each other. The Pat 6,748,365 and the Application 10/661,886 both recites transmitting a transaction code to obtain a rebate offer.

Claims 84-101 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 36-43 of copending Application No. 10/098,948. Although the conflicting claims are not identical, they are not patentably distinct from each other because both recites transmitting a transaction code to obtain a rebate offer. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 84-99 and 101 are rejected under 35 U.S.C. 102(e) as being anticipated by Finsterwald (US 6,039,244).

As per claim 84, Finsterwald teaches:

In a system where a product marketing rebate claim is submitted by a customer to a remote processing site having stored information relating to the accounts of a plurality of customers and having stored information relating to a plurality of rebate offers each associated with one or more products, a method of evaluating the satisfaction of a rebate offer associated with one or more products purchased by a customer in a transaction identifiable by a unique transaction identifier provided to a customer by a point-of sale processor at the point of sale, the method comprising the steps of

(a) receiving and electronically storing at the remote processing site information relating to the accounts of a plurality of customers (see col 5, lines 10-25);

(b) receiving and electronically storing at the remote processing site information relating to a plurality of rebate offers associated with one or more products (see col 3, lines 37-45);

(c) electronically receiving and electronically storing at the remote processing site a record of a *first* transaction at the point-of-sale processor at which one or more products were purchased with which there was associated one or more rebate offers (see col 10, lines 50-67);

(d) *assigning at the point of sale of the purchase transaction, a unique transaction identifier for the first transaction and providing the transaction identifier to the customer* (see col 9, lines 5-10);

(e) receiving from the customer at the processing site *subsequent to the completion of the first transaction* a rebate claim comprising the unique transaction identifier provided by the point-of-sale processor to the customer at a point of sale (see col 9, lines 5-25); and

(f) using at the processing site the unique transaction identifier received from the customer at the processing site to electronically evaluate the satisfaction of a rebate offer associated with the products purchased in the *first* transaction (see col 10, lines 50-67; col 3, lines 35-45).

As per claim 85, Finsterwald teaches:

The method of Claim 84 wherein the claim is electronically submitted by the customer and wherein the transaction records stored at the processing site are electronically accessed by the unique transaction identifier (see col 10, lines 50-67).

As per claim 86, Finsterwald teaches:

In a system where a product marketing rebate claim is submitted by a customer to a processing site having stored information relating to the accounts of a plurality of customers and having stored information relating to a plurality of rebate offers, a method of evaluating the satisfaction of a rebate offer associated with one or more products purchased by a customer in a transaction identifiable by a unique transaction

Art Unit: 3622

identifier provided to a customer at the point of sale *of the transaction*, the method comprising the steps of

(a) electronically receiving and storing at a processing site an electronic record of a *first* transaction at which one or more products were purchased with which there was associated one or more rebate offers (see col 10, lines 50-67);

(b) at the processing site receiving from the customer *subsequent to the completion of the first transaction* information provided to the customer at the point of sale including a unique transaction identifier *for the first transaction* (see col 9, lines 5-25), and

(c) using at the processing site the unique transaction identifier received from the customer to evaluate the satisfaction of the rebate offers associated with the products purchased in the *first* transaction (see col 10, lines 50-67; col 3, lines 35-45).

As per claim 87, Finsterwald teaches:

The method of Claim 86 wherein a plurality of products *purchased in the first transaction* have a rebate offer associated *therewith* (see col 3, lines 35-45).

As per claim 88, Finsterwald teaches:

The method of Claim 86 wherein a plurality of rebate offers are associated with a product purchased in the *first* transaction (see col 6, lines 20-30).

As per claim 89, Finsterwald teaches:

The method of Claim 86 wherein a plurality of unique transaction identifiers is received from the customer at the processing site in a single submission by the customer (see col 9, lines 60-65).

Art Unit: 3622

As per claim 90, Finsterwald teaches:

The method of Claim 86 wherein, in addition to the unique transaction identifier, the customer is provided *at the time of the first transaction* with information relating to a rebate offer associated with a product purchased in the *first* transaction (see col 3, lines 35-45).

As per claim 91, Finsterwald teaches:

The method of Claim 90 wherein the rebate offer information provided to the customer includes a dedicated accounting of products with which rebate offers are associated (see col 3, lines 35-45).

As per claim 92, Finsterwald teaches:

The method of Claim 90 wherein the rebate offer information provided to the customer identifies the terms of the rebate offer (see col 3, lines 35-45).

As per claim 93, Finsterwald teaches:

The method of Claim 90 wherein the rebate offer information provided to the customer includes the status of a rebate offer associated with a product purchased in the *first* transaction (see col 6, lines 20-35).

As per claim 94, Finsterwald teaches:

The method of Claim 90 wherein the rebate offer information provided to the customer includes a rebate offer number associated with a product purchased in the *first* transaction (see col 7, lines 50-60).

As per claim 95, Finsterwald teaches:

The method of Claim 90 wherein information in addition to the unique transaction identifier is used at the processing site (see col 5, lines 10-20).

As per claim 96, Finsterwald teaches:

The method of Claim 95 wherein the information in addition to the unique transaction identifier used at the processing site includes customer identifying information (see col 5, lines 40-50).

As per claim 97, Finsterwald teaches:

The method of Claim 86 wherein the unique transaction identifier is printed on a receipt generated by a point-of-sale processor at the point of sale (see col 9, lines 5-10).

As per claim 98, Finsterwald teaches:

The method of Claim 86 but does not expressly teach wherein the unique transaction identifier is electronically provided to the purchaser following an on-line sale (see col 6, lines 20-40).

As per claim 99, Finsterwald teaches:

The method of Claim 86 wherein the claim is electronically submitted (see col 9, lines 15-25).

As per claim 101, Finsterwald teaches:

The method of Claim 86 wherein the processing site includes distributed data processors (see figure 1).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3622

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 100 is rejected under 35 U.S.C. 103(a) as being unpatentable over Finsterwald (US 6,039,244).

As per claim 100, Finsterwald fails to teach:

The method of Claim 86 wherein the claim is submitted by mail. However, Official Notice is taken that it is old and well known in the business art to send promotions by mail. It would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that that Finsterwald would allow customers to submit promotional code by mail as it is a old and well know to send promotional offers by mail.

Response to Arguments

6. Applicant's arguments with respect to claims 84-101 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

Art Unit: 3622

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DL

Daniel Lastra
May 5, 2007


RAQUEL ALVAREZ
PRIMARY EXAMINER